Appln. No. 09/752,037
Amendment dated March 15, 2006
Reply to Office Action mailed December 15, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 54 remain in this application. No claims have been cancelled, withdrawn, or added.

Paragraphs 2 through 5 of the Office Action

Claims 1 through 3, 7, 9 through 14, 18, 20 through 29, 31 through 39, 41, 44 through 48, and 50 through 54 have been rejected under 35 U.S.C. §102(b) as being anticipated by Novak.

Claims 4 through 6, 8, 15 through 17, 19, 30, 40, and 42 through 43 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Novak in view of Patsiokas et al.

Claim 1 requires, in part, "determining if the communication device is in a privacy *operating* mode *or* a normal *operating* mode" and "if the communication device is in the privacy *operating* mode, completing the call if a privacy mode code is entered by the caller". Claim 9 requires "determining if the communication device is in a privacy *operating* mode or a normal *operating* mode" and "if the communication device is in the privacy *operating* mode, providing a privacy mode message including a selected privacy override code to the caller".. Claim 20 requires "determining if the communication device is in a privacy *operating* mode or a normal *operating* mode" and "if the communication device is in the privacy *operating* mode, providing a privacy mode message including a selected privacy override code to the caller". Claim 25 requires "a data entry device capable of receiving input to cause the communication device to enter a privacy *operating* mode from a normal *operating* mode". Claim 35 requires "a data entry device capable of receiving input to cause the communication device to enter a privacy *operating* mode from a normal *operating* mode". Claim 37 requires "a memory capable of storing a status

Page 12 of 22

indicating if the communication device is in a privacy *operating* mode or a normal *operating* mode".

The remarks made in the "Response to Arguments" section of the Office Action will be addressed first in this response, and then the Examiner's rejections will be considered in the order of their occurrence in the Office Action.

In the "Response to Arguments" portion of the Office Action, it is stated, in part, that (emphasis added):

> Applicant also argues that Novak does not teach his system has more than one mode, and nothing indicates that the Novak system has more than one "mode". Examiner respectfully disagrees. Novak teaches the <u>privacy mode</u> is on when the answering device 4 is on. <u>The privacy mode is off when the answering device 4 is off.</u> Novak further teaches the system can be programmed such that only certain calls can be accepted at certain time. The caller's call was not acceptable (privacy mode on) at certain times by connecting (Fig. 1) answering device 4, converter 5, processor 6, memory 7 and displays to answering telephone 3 or (in Fig. 2) wired clock 10 to processor 6 to set condition upon which calls would be accepted at certain tames only. (Col. 2, lines 45-46, lines 15-32 and Col. 3, lines 9-11, lines 18-24, lines 26-29). Novak teaches the caller's call was acceptable (privacy mode off) at certain times by disconnecting (Fig. 1) device 4. 5. 6, 7 and 8 from answering telephone 3, or (Fig. 2) unwired clock 10 to processors. <u>Thus, Novak does disclose whether a communication is in a privacy mode.</u>

Again, as been pointed out previously and is made even more apparent by the amendments of the previous response, the arguments made in the Office Action focus on selected portions of the text of the claims, but conveniently ignore significant requirements of the claims that, it is clear, are not disclosed by the Novak patent. In particular, claim 1 as amended requires "determining if the communication device is in a privacy *operating* mode *or* a normal *operating* mode" and "if the communication device is in the privacy *operating* mode, completing the call if a privacy mode code is entered by the caller" (emphasis added), but the arguments supporting the rejection in the Office Action consistently refer to a "privacy mode", and

not to any "privacy *operating* mode" or "normal *operating* mode". In fact, the argument in the Office Action implicitly admits that the Novak device does not have a "normal *operating* mode" when it states that "The privacy mode is off *when the answering device 4 is off*" (emphasis added). Thus, the arguments in the Office Action concede that the Novak device has only one "operating" mode, or mode of operation, which is a "privacy mode", and one must turn the device off to take the Novak device out of the "privacy mode". However, the Novak device clearly does not perform the step of "determining if the communication device is in a privacy *operating* mode *or* a normal *operating* mode", as the Novak device has no "normal *operating* mode", just an on mode and an off mode, and as discussed previously, a "power off" state is not an "*operating* mode".

The rejection of claims 1, 9, 20, 25, 35, and 37 in the Office Action states that (emphasis in original):

> Receiving the call (Col. 1, lines 49-50), determining if the communication device is in a privacy operating mode or a normal operating mode (Col. 1, lines 50-56). The privacy mode is on when the answering device 4. is on. The privacy mode is off when the answering device 4 is off. and if the communication device is in the privacy operation mode, completing the call if a privacy mode code is entered by the caller (Col. 2, lines 2-22).

Again, there is not mention of any determination of "if the communication device is in a privacy *operating* mode *or* a normal *operating* mode", as it is conceded in the rejection that the privacy mode is off only when the device is off, and thus the device has only one *operating* mode, a "privacy mode", and otherwise the device is off.

It is therefore submitted that one of ordinary skill in the art could not be led to the required step of "determining if the communication device is in a privacy *operating* mode *or* a normal *operating* mode" since Novak only discusses a power-on condition and a power-off condition. It is therefore submitted that the Novak patent does not and cannot anticipate claim 1.

Appln. No. 09/752,037
Amendment dated March 15, 2006
Reply to Office Action mailed December 15, 2005

     The "Response to Arguments" also states that (emphasis added):

> Applicant argues that Novak does not teach if the communication
> device is in the privacy operating mode, announcing the privacy mode
> code to the caller. However, it is inherence that Novak's device can
> also provide the caller with the means to override the privacy mode in
> case of emergency by giving out the override code in the message of
> answering machine. <u>The description in Novak is intended as
> illustrative only and is not to be interpreted in the limiting sense.</u>

Contrary to the last statement in this portion of the rejection of the Office
Action, the disclosure of a reference is limited to what it discloses to one of
ordinary skill in the art. The Examiner appears to be confusing the
statement that the specification cannot be used to limit the scope of the
claims, but that does not mean that a reference can disclose more than it
actually discloses.

     It has been previously noted that the Novak patent at col. 1, lines 50
through 56 states (emphasis added):

> In operation, incoming telephone calls 1 to answering telephone 3
> are first intercepted by a telephone answering device 4 which, upon
> answering the call, would transfer incoming signals to an analog to
> decimal converter 5. As shown in FIG. 2, the answering device 4 could
> also, via message sender 9, convey an answering message to the caller
> to the effect that his call had been answered by an automatic device
> and invite the caller to transmit a predetermined code, but said
> message would not be essential to the operation of the invention.

This portion of the Novak patent indicates that the "answering telephone"
"intercepts" all calls and sends the incoming calls to the telephone
answering device of the Novak system, which answers all calls. However,
nothing here indicates that the Novak system has more than one "mode", and
particularly nothing here indicates that the Novak has a privacy operating
mode that, when invoked, completes a call if the caller enters a privacy
mode code, as required by applicant's claim 1. In contrast, it appears from
the discussion in the Novak patent that the telephone answering device
answers all calls and *requires the entry of a predetermined code from all
callers at all times*, without the system having any "operating mode" to be

Appln. No. 09/752,037
Amendment dated March 15, 2006
Reply to Office Action mailed December 15, 2005

determined. In other words, the Novak system does not have any type of
operation in which the caller does not have to enter the predetermined code
that might be differentiated from its type of operation that requires the
caller to enter (or attempt to enter) the predetermined code. This
interpretation is confirmed further on in the Novak patent, where it is stated
at col. 1, lines 65 through 68:

> Upon having his call answered, the caller would transmit, via the
> answering device 4 to the analog to decimal converter 5 a
> predetermined code of one or more tones.

Again, this discussion indicates that the caller is required to transmit the
predetermined code, and nothing suggests that there is any exception to this
requirement. Further, it should be recognized that the different treatment of
calls based upon the particular predetermined code transmitted by the caller
after the caller has been required to enter the predetermined code does not
amount to any privacy operating mode different from a normal operating
mode, since all callers are still required to enter the predetermined code
regardless of how the Novak system may treat the calls after the code has
successfully been entered. This similar treatment of all calls is also
illustrated in Figure 2 of the drawings of Novak, where it can be seen that
all calls follow the same path at least until the caller enters (or attempts to
enter) the appropriate predetermined code.

It is therefore submitted that the Novak patent does not disclose or
suggest to one of ordinary skill in the art any determination of whether a
communication is in a privacy operating mode or a normal operating mode,
since the Novak system does not have any manner of operation or mode
other than its unalterable manner of handling calls by requiring the caller to
enter a code regardless of any "mode" of the Novak device.

Additionally, independent claim 20 includes the requirements
"determining if the communication device is in a privacy operating mode of
a normal operating mode" and "if the communication device is in the

Page 16 of 22

privacy operating mode, completing the call if a predetermined code is entered by the caller" discussed above with respect to claim 1, and for the reasons set forth above with respect to claim 1, claim 20 is also submitted to be patentable over the Novak patent.

Claim 2 requires "if the communication device is in the privacy operating mode, routing the call to a message system if no privacy mode code is entered by the caller". As noted above, the caller to the Novak system is always required to enter the predetermined code, and thus there is no difference in the handling of the call because of the presence of a "privacy operating mode". The Novak system always directs the call to a message system if the wrong code is entered, without regard for any "privacy operating mode".

Claim 6 requires "receiving a request from the communication device to place the communication device *in the privacy operating mode from the normal operating mode*". Conversely, claim 8 requires "receiving a request from the communication device to place the communication device *out of the privacy operating mode*". As noted above, the Novak system has no provision for placing its telephone answering device in a "privacy operating mode" different from any other mode, since all incoming calls are required to enter the predetermined code and are thus all handled in the same manner at all times, and thus the Novak patent cannot teach one of ordinary skill in the art to move a communication device in and out of a privacy operating mode.

Independent claim 9, in addition to requiring "determining if the communication device is in a privacy operating mode or a normal operating mode", also requires "if the communication device is in the privacy operating mode, providing a privacy mode message *including a selected privacy override code to the caller*" (emphasis added). (Claim 22 includes similar requirements.) This feature of the invention allows the caller to be

Appln. No. 09/752,037
Amendment dated March 15, 2006
Reply to Office Action mailed December 15, 2005

put on notice that the user of the communication device desires privacy, but also provides the caller with the means to override the privacy operating mode so that, in the case of an emergency, the caller is able to get the call completed to the communication device without prior knowledge of the privacy operating mode or override code.

Aside from the Novak system lacking any distinction between any modes of handling incoming calls, it is submitted that that the Miller patent would never lead one of ordinary skill in the art to "provid[e] a privacy mode message including a selected privacy override code to the caller", as this would render the Novak system completely useless for its intended purpose of preventing unwanted callers (who have not been specifically provided with a predetermined code by the user) from being able to stop those calls from being rung through. If the Novak system included a message that included the predetermined code, any caller would be able to circumvent the Novak system. One of ordinary skill in the art would not modify the Novak system in a manner that would render the Novak system ineffective for its primary intended purpose. Therefore, claim 9, as well as claims 10 through 19 which depend from claim 9, and claim 22, as well as claims 23 and 24 which depend from claim 22, are submitted to define over the Novak patent.

Independent claim 25 requires "a data entry device capable of receiving input to cause the communication device to enter a privacy operating mode" and "a receiver capable of completing the call to the user if a privacy mode code is entered by the caller". It has been shown above that the user cannot affect the manner in which the Novak system handles incoming calls--all callers are required to enter a predetermined code--and thus there is no provision for "enter[ing a communication device into] a privacy operating mode". Therefore claim 25, as well as claims 26 through 30 which depend from claim 25, are submitted to not be anticipated by the Novak patent and are in condition for allowance.

Independent claim 31, similar in some respects to claim 9, requires "a data entry device capable of receiving input to cause the communication device to enter a privacy operating mode from a normal operating mode" and "a memory capable of providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user". As noted above with respect to claim 9, the Novak document would never lead one of ordinary skill in the art to "providing a privacy mode message including a selected privacy override code to the caller prior to completing the call to the user", as this would render the Novak system utterly ineffective in blocking telemarketer calls. Claim 31, as well as claims 32 through 34 which depend from claim 32, are therefore submitted to be allowable over the Novak patent.

Independent claim 35 requires "a data entry device *capable of receiving input to cause the communication device to enter a privacy mode*" (emphasis added) and "a receiver capable of receiving the call to the communication device and completing the call to the user only if an interrupt is received from the caller". As noted on several occasions above, the Novak system lacks any ability to change the way in which incoming calls are handled, and thus there is no privacy mode to enter from any other mode. Thus, it is submitted that the Novak patent does not anticipate the requirements of claim 35, and therefore claim 35, as well as claim 36 which depends from claim 35, are submitted to be in condition for allowance.

Independent claim 37 requires "a memory capable of storing a status indicating if the communication device is in a privacy operating mode or in a normal operating mode" and "a transmitter capable of completing the call to the user if the communication device is in the privacy operating mode and the privacy mode code is entered by the caller". In addition to the Novak system lacking any mode that is different from its single manner of operation, the Novak system lacks any manner for storing a status indicating

that the Novak system is in such a privacy operating mode. As noted previously, the user of the Novak system is incapable of changing the requirement that the incoming callers enter the predetermined code, so storing a status of a mode of handling calls is not implied.

Claim 51 requires that "if the communication device is in the privacy operating mode, announcing the privacy mode code to the caller", and claim 52 requires that "the step of providing a privacy mode message includ[e] a selected privacy override code to the caller further comprises announcing the privacy override code to the caller". This requirement is contrary to the Novak system, as the Novak patent clearly states that one of its objects is to *mask* the presence and function of the Novak system from the caller. See, e.g., Novak at col. 1, lines 29 through 36 (emphasis added):

> Another object of the invention is for the device to operate without divulging to the caller why his call was not answered. It would thus prevent burglers from correctly assuming that an unanswered call indicated that the called party was not at home. Conversely, it would allow a user to not answer a call without offending a caller, as that caller would have no way of knowing that the user was, in fact, at home.

Clearly, "announcing the privacy mode code to the caller" is anathema to the objects of the Novak patent, as the caller would clearly realize that his or her call was subject to screening by the privacy operating mode if it were announced.

Claim 53 requires "the step of receiving a spoken command from a user of the communication device to place the communication device in the privacy operating mode", and as the manner in which the Novak system handles incoming calls cannot be altered, it is submitted that this feature is foreign to the Novak system.

Claim 54 requires that "if the communication device is in the privacy operating mode, preventing the communication device from producing an incoming call signal if the privacy mode code is not entered by the caller

Page 20 of 22

while providing information regarding the incoming call through a display on the communication device". Again, the Novak patent does not provide for any variation from the single manner of operation that requires all callers to enter a predetermined code, and thus it is submitted that Novak cannot anticipate this requirement.

Withdrawal of the §102(b) rejection of claims 1 through 3, 7, 9 through 14, 18, 20 through 29, 31 through 39, 41 and 44 through 54 is therefore respectfully requested.

It has also been previously stated by the applicant that the Patsiokas patent does not make up for the shortcomings of the Novak patent in anticipating the requirements of the claimed invention, particularly the lack of a privacy mode that may be placed on or removed from a communication device.

In particular, the Patsiokas et al. patent states at col. 3, lines 35 through 44 (emphasis added) that:

> For emergency calls, each remote unit operator may provide selected individuals with a pre-programmed "Override Code." Thus, if a call originator is informed that a particular remote unit is in the Message Storage mode, and the call originator enters the appropriate Override Code through the call originator's telephone or remote unit keypad, voice communications will be established between the call originator and the called remote unit, despite the fact that the remote unit is currently in the Message Storage mode.

In light of this statement in the Patsiokas patent that the operator of the remote unit *may* provide "selected" people with an "override code", it is clear that since only some people have the "override code", the "override code" is not a part of any message that is played for the call originator, and thus does not teach a "privacy mode message *including* a selected privacy override code" as required by claims 9, 22, and 31. Nor does Patsiokas teach that "if the communication device is in the privacy operating mode, *announcing* the privacy mode code to the caller" as required by claim 51 or

Page 21 of 22

Appln. No. 09/752,037
Amendment dated March 15, 2006
Reply to Office Action mailed December 15, 2005

"*announcing* the privacy mode code to the caller" as required by claim 52.

Further, with respect to the Patsiokas patent, it is noted that Patsiokas states that the "override code" is "pre-programmed", which leads one of ordinary skill in the art to believe that the "override code" is not "selected by a user of the communication device", as required by claims 3, 7, 14, 18, 29, 34, 41, but is instead more likely outside of the control of the user.
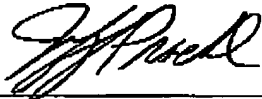
Withdrawal of the §102(b) and §103(a) rejection of claims 1 through 54 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Page 22 of 22

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